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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91265833
Party	Defendant Just Auto Insurance Services
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Date	01/25/2021
Attachments	Applicants Response to Order.pdf(16769 bytes) Complaint and Demand for Jury Trial.PDF(744408 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of

Insurance King Agency, Inc. DBA Insurance
King,

Opposer,

v.

Just Auto Insurance Services,

Applicant.

Opposition No. 91265833

Application No.: 88750818

Mark: LION LOGO

Publication Date: November 3, 2020

**APPLICANT'S RESPONSE TO ORDER
DATED JANUARY 21, 2021**

In response to the Order dated January 21, 2021, Applicant hereby submits the Civil Complaint for underlying litigation involving the application at issue in *Insurance King Agency, Inc. v. Just Auto Insurance, Inc.*, United States District Court, Central District of California, Case No. 2:20-cv-05944-PSG-GJS. Please contact the undersigned attorney for the Applicant with any questions.

Respectfully submitted,

Dated: January 25, 2021

By: /s/ Aaron L. Renfro
Aaron L. Renfro
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CERTIFICATE OF TRANSMISSION

I, Aaron L. Renfro, attorney of record for Applicant Just Auto Insurance Services, hereby certify that the foregoing APPLICANT'S RESPONSE TO ORDER DATED JANUARY 21, 2021, is being electronically transmitted via the Electronic System for Trademark Trials and Appeals ("ESTTA") at <http://estta.uspto.gov/> on January 25, 2021.

1/25/21
Date

By: /s/ Aaron L. Renfro
Aaron L. Renfro
Attorney of Record for Applicant
Just Auto Insurance Services

CERTIFICATE OF SERVICE

I, Aaron L. Renfro, attorney of record for Applicant Just Auto Insurance Services, certify that a true and correct copy of the foregoing APPLICANT'S RESPONSE TO ORDER DATED JANUARY 21, 2021 was served upon Opposer's counsel via email only, on this 25th of January 2021, at the following address:

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1/25/21
Date

By: /s/ Aaron L. Renfro
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KING AGENCY, INC.

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

INSURANCE KING AGENCY, INC.,
an Illinois corporation,

Plaintiff,

vs.

JUST AUTO INSURANCE, INC., a
California corporation, Leon Fregoso,
an individual and DOES 1 through 10,
inclusive,

Defendants.

CASE NO.

COMPLAINT FOR:

**TRADEMARK INFRINGEMENT,
15 U.S.C. §1114;**

**FALSE DESIGNATION OF
ORIGIN, UNFAIR COMPETITION
15 U.S.C. §1125(a);**

**COMMON LAW TRADEMARK
INFRINGEMENT;**

**COMMON LAW UNFAIR
COMPETITION; and**

**CALIFORNIA BUSINESS &
PROFESSION CODE § 17200 et seq.**

DEMAND FOR JURY TRIAL

Plaintiff Insurance King Agency, Inc. (“King Agency”), by and through its undersigned attorneys, hereby makes this Complaint against Defendants Just Auto Insurance, Inc. (“Just Auto”), Leon Fregoso (“Fregoso”), and Does 1-15, inclusive (collectively, “Defendants”) as follows:

JURISDICTION AND VENUE

1. This action arises under the United States Lanham Act, 15 U.S.C. §1051 *et seq.* and contains related California statutory and common law claims. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a). This Court has supplemental subject matter jurisdiction over Plaintiff's state law claims pursuant to 28 U.S.C. § 1367(a), since they are so related to the federal claims that they form part of the same case or controversy and derive from a common nucleus of operative facts.

2. This Court has personal jurisdiction over the Defendants as Just Auto's principal place of business is in Rancho Cucamonga, California, and Plaintiff is informed and believes, and based on that information and belief alleges that Defendant Fregoso resides in the State of California and within this judicial district. Furthermore, some of the infringing and unlawful conduct occurred in California. These acts form a substantial part of the events or omissions giving rise to Plaintiff's claims.

3. Venue in this judicial district is proper pursuant to 28 U.S.C. §§ 1391(b)(1), 1391(c) in that this is the judicial district in which a substantial part of the acts and omissions giving rise to the claims occurred, and the Defendants' principal place of business and residence are within the Central District of California.

NATURE OF ACTION

4. This is an action for trademark infringement, unfair competition and false designation of origin under the *Lanham Act*, 15 U.S.C. §1125(a), common law trademark infringement, statutory unfair competition under *California Business and Professions Code* §17200, and common law unfair competition.

PARTIES

5. Plaintiff King Agency is an Illinois corporation with its principal place of business at 127 N. Alpine Road, Rockford, Illinois 61107.

1 also utilizes other media and has over four million views on YouTube®.

2 12. The King Agency is also the sponsor of NASCAR driver Josh Bilicki
3 and its insuranceking.com and its Lion Logo are prominently displayed of his race
4 car as well as the bus and car carrier which travels to each race across the country.





13. The King Agency, while based in Illinois, has offices and is actively writing policies in Indiana, Iowa, Mississippi, Missouri, Kansas, Ohio, Tennessee, Texas, Wisconsin. It is licensed to issue insurance policies in Pennsylvania, Alabama and Colorado but has not done so as yet. The King Agency is also in the process of applying in other states, including California and has even received multiple requests for quotes from California residents that it must decline until its licensing in the state is complete.

14. For over twenty years, and long before the acts of the Defendants herein, the King Agency has used the marks “Insurance King” and its “Lion Logo”

1 in advertising for its services, on its signage for its brick and mortar offices as well
2 as promotional materials and in social media.

3 15. King Agency is also the owner of two trademark registrations in the
4 United States Patent and Trademark Office: Registration. 4,628,343



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7
8
9 (“343 Reg.”) and INSURANCE KING®, Registration No. 4,628,341 (“341 Reg.”)
10 (collectively “King Marks”) for “insurance brokerage services” with first use
11 claimed in April 2000. The King Marks are incontestable and copies of the
12 Registration certificates are attached as Exhibits A and B, respectively.

13 16. King Agency has developed the King Marks at great expense and such
14 are valuable and irreplaceable assets. The King Agency has invested substantial
15 sums in advertising and promotion of its services under the King Marks and such
16 have come to be recognized as identifying the King Agency and its services.

17 17. King Agency has a vital economic interest in the protection and
18 preservation of the King Marks and the maintenance of the goodwill and reputation
19 associated therewith.

20 **DEFENDANTS’ ACTIONS**

21 18. The King Agency is informed and believes that Defendant Just Auto is
22 a California corporation that provides insurance brokerage services. King Agency is
23 informed and believes that at some point in 2019 Defendant Just Auto, at the
24 direction of Fregoso began using the term “The King of Insurance” as well as a
25 design of a lion (“Just Auto lion”) in connection with the promotion of its insurance
26 brokerage services, including, but not limited to, use on its advertising and
27 promotional materials and the signage for its business locations.

28 19. On June 26, 2019 Just Auto filed an intent-to-use trademark application

1 for THE KING OF INSURANCE, Serial No. 88/490,757 (“757 App.”) for
 2 insurance for personal and commercial needs, namely, auto insurance brokerage
 3 services and auto insurance consultancy services.

4 20. On January 8, 2020 Just Auto filed a trademark application for a “Lion”
 5 design (“Just Auto lion”), Serial No. 88/750,818 (“818 App.”) for auto insurance
 6 brokerage services and auto insurance consultancy services claiming first use on
 7 June 25, 2019. (Exhibit C - image from the PTO’s TESS system).

8 21. On January 14, 2020 Just Auto filed two additional trademark
 9 applications, one for JUST AUTO INSURANCE SERVICES, INC., Serial No.
 10 88/758,189 for insurance brokerage services; insurance consultancy and JUST
 11 AUTO INSURANCE, Serial No. 88/758,194 for insurance brokerage services;
 12 insurance consultancy claiming first use for both marks on March 11, 2007. (“Just
 13 Auto Apps.”)

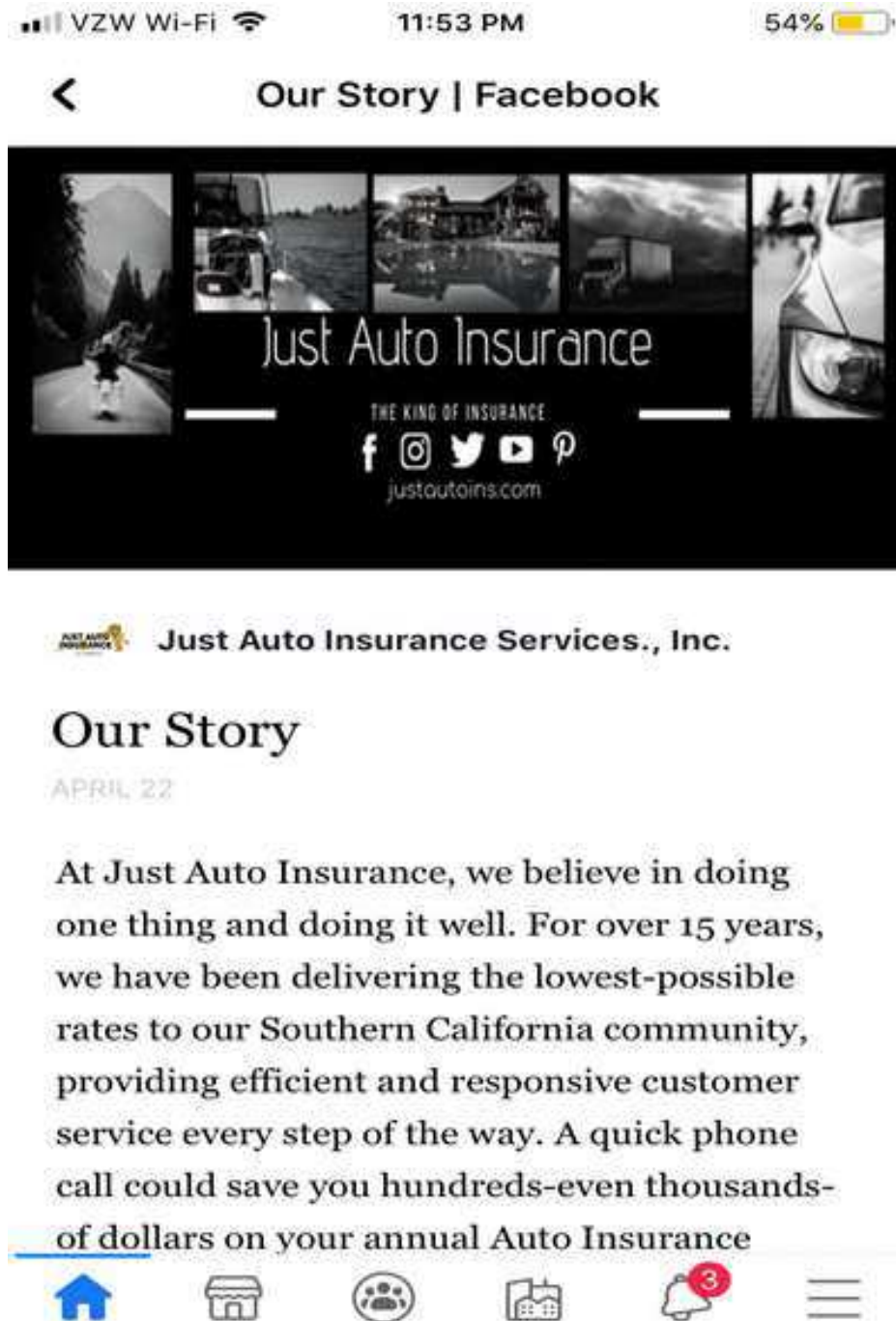
14 22. The ‘757 App has been abandoned after King Agency advised
 15 Defendants that it objected to the use/application for “The Insurance King” and the
 16 “Just Auto lion”, but despite repeated requests to cease, Just Auto, at the direction of
 17 Defendant Fregoso, continues to use “The King of Insurance” as well as the “Just
 18 Auto lion” for its business and the specimens for the ‘818 App. and the Just Auto
 19 Apps. all include the “Just Auto lion” as found in the ‘818 App. and the phrase “The
 20 King of Insurance”. (Exhibit “D” hereto).

21 23. Defendants continued willful infringement of the King Marks includes:
 22 (1) Use of the “Just Auto lion” on their signage:



4850-5545-

(2) Use of the “Just Auto lion” and “The King Of Insurance” on Just Auto’s Facebook page:



(3) Defendants' television commercial which prominently displays the "Just Auto lion":



24. Defendants by their unauthorized use of "The King of Insurance" and the "Just Auto lion" and related activities have engaged in the acts of trademark infringement, false designation of origin and unfair competition.

25. Defendants' activities have damaged and will continue to damage the reputation, business and goodwill of the King Agency, including, but not limited to the fact that Defendant Just Auto has received negative reviews from consumers and due to Defendants' acts as described herein, such are being ascribed to the King Agency. Unless enjoined by the Court, Defendants will continue and further escalate their unlawful activities.

26. King Agency has no adequate remedy at law and Defendants' activities have caused and, if not enjoined, will continue to cause irreparable harm to King Agency including its business reputation and goodwill.

FIRST CAUSE OF ACTION

(For Trademark Infringement, 15 U.S.C. §1114)

(Against All Defendants)

27. The King Agency realleges, and incorporates herein by this reference

1 the allegations contained in paragraphs 1 – 26, above, as though fully set forth
2 herein.

3 28. Defendants' unauthorized use in commerce of "The King of Insurance"
4 and the "Just Auto lion", or confusingly similar variations thereof, despite repeated
5 demands by the King Agency to cease in connection with their advertising,
6 marketing, and provision of insurance brokerage services, as alleged herein, is likely
7 to cause confusion, to cause mistake, or to deceive consumers.

8 29. Defendants' acts, alleged herein, constitute willful federal trademark
9 infringement in violation of Section 32 of the Lanham Act, 15 U.S.C. §1114.

10 30. By reason of Defendants' actions, the King Agency has suffered
11 irreparable harm to its valuable trademarks and the goodwill associated therewith.
12 King Agency has been and, unless Defendants are preliminarily and permanently
13 restrained from their actions, will continue to be irreparably harmed. King Agency
14 has no adequate remedy at law and therefore seeks injunctive relief under 15 U.S.C.
15 § 1116.

16 31. Defendants knew or should have known that their use of "The King of
17 Insurance" and the "Just Auto lion" were likely to confuse and mislead consumers
18 as to the source of their services. Indeed, as alleged above, Defendants were well
19 aware that the complained of acts herein would result in consumers being confused
20 and it was that very confusion that Defendants hoped to and did, on information and
21 belief, profit from. Accordingly, this is an exceptional case under 15 U.S.C. §1117
22 (a).

23 32. As a direct and proximate result of the foregoing acts, practices, and
24 conduct of Defendants, the King Agency has been substantially injured in its
25 business resulting in lost revenues and profits in an amount to be proven at trial but
26 which exceeds \$75,000, and diminished goodwill and reputation and is entitled to
27 the profits earned by Defendants attributable to the wrongful conduct alleged herein.

28 33. Defendants acts were willful and King Agency is entitled to recover

1 reasonable attorneys' fees and costs under 15 U.S.C. § 1117.

2 **SECOND CAUSE OF ACTION**

3 **(False Designation of Origin, Unfair Competition 15 U.S.C. §1125(a))**

4 **(Against All Defendants)**

5 34. King Agency realleges, and incorporates herein by reference
6 Paragraphs 1-33, above, as though fully set forth herein.

7 35. Defendants' unauthorized use in commerce of "The King of Insurance"
8 and the "Just Auto lion", or confusingly similar variations thereof, despite repeated
9 demands by the King Agency to cease, in connection with their advertising,
10 marketing, and providing of insurance brokerage services, as alleged herein, is likely
11 to cause confusion, to cause mistake, or to deceive consumers as to the origin,
12 source, sponsorship or affiliation of Defendants' services and is likely to cause
13 consumers to erroneously believe that Defendants' services are in some way
14 affiliated with the King Agency.

15 36. Defendants knew or should have known that their use of "The King of
16 Insurance" and the "Just Auto lion" was likely to confuse and mislead consumers as
17 to the source of their services. Defendants were well aware that the complained of
18 acts herein would result in consumers being confused. It was that very confusion
19 that Defendants hoped to and did, on information and belief, profit from.

20 37. As a direct and proximate result of the foregoing acts, practices, and
21 conduct of Defendants, the King Agency has been substantially injured in its
22 business resulting in lost revenues and profits, and diminished goodwill and
23 reputation.

24 38. As a direct and proximate result of the foregoing acts, practices, and
25 conduct of Defendants, King Agency has sustained and will continue to sustain
26 substantial, immediate, and irreparable injury for which there is no adequate remedy
27 at law, including without limitation the loss of consumer goodwill and unless
28

1 enjoined and restrained by the Court, Defendants will continue to engage in conduct
 2 in violation of the Lanham Act and Defendants actions render the matter exceptional
 3 under 15 U.S.C. §1117(a).

4 39. As a result of Defendants' acts, King Agency has suffered damages in
 5 an amount to be proven at trial but which exceeds \$75,000. King Agency is further
 6 entitled to attorneys' fees and costs, and the profits earned by Defendants
 7 attributable to their wrongful conduct.

8 **THIRD CAUSE OF ACTION**
 9 **(Common Law Trademark Infringement)**
 10 **(Against All Defendants)**

11 40. King Agency realleges, and incorporates herein by reference
 12 Paragraphs 1-39, above, as though fully set forth herein.

13 41. King Agency was the first to use Insurance King and the Lion Logo in
 14 the '343 Reg. in connection with insurance brokerage services and as a result such
 15 have become associated with the King Agency and its insurance services and results
 16 in the King Agency's acquisition of common law trademark rights in and to the
 17 King Marks.

18 42. Defendants have violated the King Agency's exclusive common law
 19 trademark rights in and to the King Marks through their intentional disregard for
 20 King Agency's rights by their advertisements and continued use of "The King of
 21 Insurance" and the "Just Auto lion" in the promotion of their services. Such acts are
 22 likely to cause, and have caused and will continue to cause confusion as to the
 23 source or sponsorship of Defendants' services.

24 43. Defendants' acts described herein constitute willful infringement of the
 25 King Agency's rights, in violation of the common law.

26 44. By reason of Defendants' actions, the King Agency has suffered
 27 irreparable harm and unless Defendants are restrained from further infringement of
 28 the King Marks, the King Agency will continue to suffer irreparable harm. The

King Agency has no remedy at law that will adequately compensate it for such irreparable harm if Defendants' conduct is allowed to continue.

45. As a result of Defendants' actions, the King Agency has suffered damages in an amount to be proven at trial but which exceeds \$75,000 and is entitled to attorneys' fees and costs, the profits earned by Defendants attributable to their wrongful conduct and injunctive relief.

FOURTH CAUSE OF ACTION
(Common law Unfair Competition)
(Against All Defendants)

46. The King Agency realleges, and incorporates herein by reference Paragraphs 1-45, above, as though fully set forth herein.

47. Defendants' use of "The King of Insurance" and the "Jut Auto lion", or confusingly similar variations thereof, despite repeated demands by the King Agency to cease, in connection with their advertising, marketing, and providing of insurance brokerage services, as alleged herein, is likely to cause confusion, to cause mistake, or to deceive consumers as to the origin, source, sponsorship or affiliation of Defendants' services and is likely to cause consumers to erroneously believe that Defendants' services are in some way affiliated with o cconstitutes unfair competition, and is likely to cause confusion and mistake in the minds of consumers as to the source of the parties' goods and services.

48. King Agency is informed and believes and on such information and belief alleges that Defendants' acts, as alleged herein, were taken with the intent of causing confusion, mistake, and deception as to the source of their services and improperly trading upon the reputation and goodwill of the King Agency and impairing the valuable rights in its King Marks.

49. Defendants' acts herein were and are willful and intentional acts of unfair competition.

50. By reason of Defendants' actions, the King Agency has suffered

1 irreparable harm and unless Defendants are restrained from further infringement of
 2 the King Marks, the King Agency will continue to suffer irreparable harm. The King
 3 Agency has no remedy at law that will adequately compensate it for such irreparable
 4 harm if Defendants' conduct is allowed to continue.

5 51. As a result of Defendants' actions, the King Agency has suffered
 6 damages in an amount to be proven at trial but which exceeds \$75,000 and is
 7 entitled to attorneys' fees and costs, the profits earned by Defendants attributable to
 8 their wrongful conduct and injunctive relief.

9 **FIFTH CAUSE OF ACTION**

10 **(California Statutory Unfair Competition – California Business & Profession** 11 **Code § 17200 et seq.)**

12 **(Against all Defendants)**

13 52. The King Agency realleges, and incorporates herein by reference
 14 Paragraphs 1-51, above, as though fully set forth herein.

15 53. Defendants, through the conduct alleged herein, have engaged in and
 16 continue to engage in trademark infringement, unlawful, unfair, and/or fraudulent
 17 conduct in violation of Section 17200, *et seq.* of the *California Business and*
 18 *Professions Code*. Defendants have also engaged in and continue to engage in
 19 conduct that is deceptive, untrue and misleading in violation of *California Business*
 20 *and Professions Code* Section 17500, which also constitutes a violation of Section
 21 17200.

22 54. As a result of the foregoing, the King Agency has adequate remedy at
 23 law such that monetary damages alone will not fully compensate for Defendants;
 24 blatant misconduct and unless enjoined by the Court, Defendants will continue to
 25 violate the King Agency's rights.

26 55. As a result of the foregoing, the King Agency is entitled to injunctive
 27 relief pursuant to *California Business and Professions Code* Section 17203.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Insurance King Agency prays for judgment as follows:

A. For general, compensatory and special damages according to proof at the time of trial including an enhancement by the Court as set forth in 15 U.S.C 1117;

B. For a disgorgement of the profits earned by Defendants that are attributable to the wrongful acts set forth herein pursuant to 15 U.S.C. 1117;

C. For a determination that this case is “exceptional” and that Defendants be ordered to pay the reasonable attorneys’ fees and costs incurred by Plaintiff in prosecuting this action pursuant to 15 U.S.C. 1117;

D. For the grant of a permanent injunction enjoining Defendants from using the “The King of Insurance” and the lion logo, or any confusingly similar marks, in connection with the marketing, promotion, or advertising of Defendants’ services.

E. For punitive damages in an amount to be determined at trial;

F. For the costs of this action and for pre-judgment interest as allowed by law; and

G. For any such further legal and equitable relief as the Court deems proper.

DATED: July 1, 2020

DANIEL C. DECARLO

THOMAS S. KIDDÉ

SASHA SHARIATI

LEWIS BRISBOIS BISGAARD & SMITH LLP



By: _____

Daniel C. DeCarlo

Attorneys for Plaintiff INSURANCE
KING AGENCY, INC.

DEMAND FOR JURY TRIAL

Plaintiff Insurance King Agency, Inc. hereby demands trial by jury on all matters so triable.

DATED: July 1, 2020

DANIEL C. DECARLO
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